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EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2171

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DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/892,721

Applicant(s)

MORI ET AL.

Examiner

Brian Goddard

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This communication is responsive to Amendment A, filed 25 March 2004.
2. Claims 1-46 are pending in this application. Claims 1, 4, 20, 23-25, 30-33 and 43-44 are independent claims. In Amendment A, claims 1, 4, 20, 23-25, 30-33 and 43-44 were amended. This action is made Final.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3, 23 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,336,073 to Ihara et al.

Referring to claim 1, Ihara discloses a server in a system providing information to a user terminal being able to display a map as claimed. See Figures 1-16 and the corresponding portions of Ihara's specification for this disclosure. In particular, Ihara teaches "a server [310-370] in a system [Fig. 1] providing information to a user terminal [100] being able to display a map comprising:

a database [See column 16, line 50 – column 17, line 43] for holding a specific information document as bubble data [See below], the specific information document having index information [phone number, address, name, coordinates, etc.] composed of a plurality of elements, being from out of information documents having attribute information [See Fig. 7] representing attributes of service information [POI information

(See Fig. 7d)] to be provided, in which spatial range information [POS] in three-dimensional space [See column 8, lines 16-18] is associated with retrieval information for obtaining said service information;

a retrieving unit [350-370] for retrieving specific bubble data [Detailed POI information] including coordinate information [POS] and display object attribute information [See Figs. 7, 12 & 13] on the basis of a mapping request [Step S302, S505 or S509] having said coordinate information [POS] on an object [POI] displayed on said map and said display object attribute information representing attributes of service information to be provided by said object, said mapping request being transmitted from said user terminal [100]; and

a notifying unit [340] for notifying said user terminal of a mapping response [See Figs. 13-14] having said spatial range information, said attribute information and said retrieval information, wherein said spatial range information, said attribute information and said retrieval information being included in said specific bubble data which is retrieved in said retrieving unit [See above]" as claimed.

Referring to claim 2, Ihara discloses the server as claimed. See Figures 13-14 and the corresponding portions of Ihara's specification for this disclosure. In particular, Ihara teaches the server according to claim 1, as above, "wherein said notifying unit notifies of said mapping response having spatial range information including a similar bubble diameter [dispsize] having a diameter according to a scale of a map displayed on said user terminal and address information [See column 17, line 31 – column 18, line 45]" as claimed.

Referring to claim 3, Ihara discloses the server as claimed. See Figure 7 and the corresponding portion of Ihara's specification for this disclosure. Ihara teaches the server according to claim 1, as above, "wherein said database correlates said bubble data [See Fig. 7d] with a unique number [POI-ID] by which contents of service information [POI information] of said bubble data can be identified, and holds said bubble data and said unique number" as claimed.

Referring to claim 23, Ihara discloses the user terminal in a system providing information to said user terminal being able to display a map as claimed. See Figures 1-2 and the corresponding portions of Ihara's specification, as well as the discussions regarding claims 1-3 above for the details of this disclosure. Ihara teaches "a user terminal [100]... comprising:

- a map information outputting unit [107]...;
- a display unit [108]...;
- a transmitting unit [109]...;
- a receiving unit [106]...;
- a mapping unit [104]...; and
- a mapping data holding unit [103]..." as claimed.

Referring to claim 32, Ihara discloses the information providing service method in a system providing information to a user terminal being able to display a map as claimed. See Figures 1-17 and the corresponding portions of Ihara's specification, as well as the discussions regarding claims 1 and 23 above for the details of this

disclosure. Ihara teaches "an information providing service method [See Figs. 3-6]...comprising the steps of:

selecting an object [S201, S301 or S505]...;

transmitting...coordinate information [See transmitting unit in claim 23]...;

transmitting spatial range information [See retrieving unit and notifying unit in claim 1]...; and

displaying...an image geometry [See mapping unit in claim 23]..." as claimed.

#### ***Claim Rejections - 35 USC § 103***

4. Claims 4-22, 24-31 and 33-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ihara in view of U.S. Patent No. 6,487,495 to Gale et al.

Referring to claim 4, Ihara discloses the server in a system providing information to a user terminal being able to display a map as claimed. See the discussion regarding claims 1-3 above for the details of this disclosure. Ihara's spatial range information explicitly includes latitude and longitude, as shown in Fig. 7c and discussed throughout the specification. Ihara also teaches that a third dimension is optionally included with the spatial range information as shown by reference element 370. However, Ihara is silent on the measure of the third dimension. Thus, Ihara does not explicitly teach that the spatial range information includes altitude (as claimed), but does explicitly teach that a third dimension is used.

Gale discloses a system and method very similar to that of Ihara, in which latitude and longitude are used as anchor coordinates, with an optional use of altitude

as a third dimension in order to provide the ability to specify elevation or a relative altitude (e.g. number of levels above or below street level) of a desired object. See column 5, lines 43-64 and column 9, lines 44-59 of Gale's specification for the details of this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Gale's use of altitude as the optional third coordinate in Ihara's system because this would enable the user to specify elevation (or number of levels above/below street level) of the desired object. One would have been motivated to modify Ihara as such because of Ihara's silence on the measure of the optional third dimension as discussed above.

Referring to claim 5, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See the discussion regarding claim 2 in light of the basis for claim 4 above.

Referring to claim 6, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figure 1 and the corresponding portion of Ihara's specification for this disclosure. Ihara's (as modified by Gale) retrieving unit retrieves said specific bubble data [Detailed POI information] in another database [350] connected to a network [400] on the basis of said mapping request as claimed.

Referring to claim 7, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figure 1 and the corresponding portion of Ihara's specification for this disclosure. Ihara's (as modified by Gale) server further comprises a Web information outputting unit [200] for holding user [subscriber]

information [See column 7, lines 47-67] and an address generating unit [310 / 320] for generating an address [URL] at which said user information held in said Web information outputting unit is held as claimed.

Referring to claim 8, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figures 7d, 12 & 13 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale) database holds an animation element [image, audio, video, etc.] to be displayed on said user terminal [See Fig. 13] in document type definition [See Figures 7 & 12] information as claimed.

Referring to claims 9-11, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figures 7 & 12 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale) database holds an application program element [Conversion Program (See Fig. 12)] and a communication partner information element [See Figs. 7d & 12b], and classifies document type definition information [See Fig. 7] as claimed.

Referring to claim 12, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See the discussion regarding claim 3 in light of the basis for claim 4 above.

Referring to claim 13, the system of Ihara in view of Gale as applied to claim 12 discloses the invention as claimed. See Figures 6 & 13-17 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale) database "holds monitoring bubble data [Present POS Location] for detecting a moving



object [vehicle, mobile phone, pda, etc.] and a bubble diameter [dispsize] of said monitoring bubble data based on position information on said moving object, and records a moving object element by which said moving object can be specified in a file held in said database [See Figs. 13-17]" as claimed.

Referring to claim 14, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figure 14 and the corresponding portion of Ihara's specification, and the discussion of claim 2 above, in light of the basis for claim 4.

Referring to claim 15, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figure 1 and the corresponding portion of Ihara's specification for this disclosure. Ihara's database holds at least either one of history information of address information caused by an access of said user terminal and identifier information [PPP address] by which said user terminal can be identified in a file as claimed.

Referring to claims 16-17, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See Figures 7 & 12 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale) database holds data relating to a counter [<service> information] and data relating to an accessible time [<worktime> information] in a file as claimed.

Referring to claim 18, the system of Ihara in view of Gale as applied to claim 4 discloses the invention as claimed. See the discussion regarding claim 9 above for the details of this disclosure.

Referring to claim 19, the system of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See Figures 7 & 12 and the corresponding portions of Ihara's specification for this disclosure. Ihara's (as modified by Gale) database handles address information [See Fig. 7d & 12] based on said spatial range information [POS] as an electronic mail address [<address> information], and holds said spatial range information correspondingly to said electronic mail address as claimed.

Claim 20 is rejected on the same basis as claim 4. See the discussions regarding claims 1 and 4 above for the details of this disclosure.

Claims 21-22 are rejected on the same basis as claims 5 & 12 respectively, in light of the basis for claim 20. See the discussions regarding claims 1-5 and 12 above for the details of this disclosure.

Referring to claim 24, the system of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See the discussions regarding claims 4 and 23 above for the details of this disclosure.

Claim 25 is rejected on the same basis as claim 24. See the discussions regarding claims 1, 4 and 23 above for the details of this disclosure.

Claim 26 is rejected on the same basis as claim 5, in light of the basis for claim 25. See the discussions regarding claims 1-5 and 23 above for the details of this disclosure.

Referring to claims 27-28, the system of Ihara in view of Gale as applied to claim 25 above discloses the invention as claimed. See Figure 2 and the corresponding portion of Ihara's specification for this disclosure. Ihara's (as modified by Gale) user

terminal [100] further comprises a detecting unit [102] for detecting position information...wherein said detecting unit comprises...a satellite information receiving unit being able to receive satellite information through the use of a global positioning system...as claimed.

Claim 29 is rejected on the same basis as claim 19, in light of the basis for claim 25. See the discussions regarding claims 1-4, 19 and 23 above for the details of this disclosure.

Referring to claims 30-31, the system of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See the discussions regarding claims 4 and 24 above for the details of this disclosure.

Referring to claims 33-34, the system of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See the discussions regarding claims 4 and 32 above for the details of this disclosure.

Claim 35 is rejected on the same basis as claim 5, in light of the basis for claim 33. See the discussions regarding claims 1-5 and 33 above for the details of this disclosure.

Claim 36 is rejected on the same basis as claims 16-17, in light of the basis for claim 35. See the discussions regarding claims 1-5, 16-17 and 33-35 above for the details of this disclosure.

Claim 37 is rejected on the same basis as claim 9, in light of the basis for claim 33. See the discussions regarding claims 1-4, 9 and 33 above for the details of this disclosure.

Claims 38-39 are rejected on the same basis as claims 16-17, in light of the basis for claim 33. See the discussions regarding claims 1-4, 16-17 and 33 above for the details of this disclosure.

Referring to claim 40, the system and method of Ihara in view of Gale as applied to claim 33 above discloses the invention as claimed. Neither Ihara nor Gale explicitly states that retrieval is performed on the basis of the number of accesses that the server can receive concurrently as claimed. However, the examiner takes Official notice that it was common knowledge in the art at the time of applicants' invention to perform accesses to a server (such as Ihara's) based on the number of accesses the server could receive concurrently. In other words, if a server was concurrently handling the maximum number of concurrent accesses when another process desired access to the server, the new process would have to wait for a concurrent process to finish in order to gain access to the server. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Ihara's server performed retrieval on the basis of the number of accesses that said server could receive concurrently, because of the desire to keep from overloading the server with more accesses than it could handle concurrently.

Claims 41-42 are rejected on the same basis as claims 10 and 13, in light of the basis for claim 33. See the discussions regarding claims 1-4, 10, 13 and 33 above for the details of this disclosure.

Claim 43 is rejected on the same basis as claim 33. See the discussions regarding claims 32 and 33 above for the details of this disclosure.

Referring to claims 44-46, the system and method of Ihara in view of Gale as applied to claim 4 above discloses the invention as claimed. See the discussions regarding claims 4-19 and 33-42 above for the details of this disclosure.

### ***Response to Arguments***

5. Applicant's arguments filed 25 March 2004 have been fully considered but they are not persuasive.

Referring to applicants' remarks on pages 27-30 regarding the Sections 102 and 103 rejections of the independent claims: Applicants argued that neither Ihara nor the combination of Ihara and Gale teach or suggest the spatial range information composed of a "bubble diameter" of an object.

The examiner disagrees for the following reasons: First, it is noted that the limitations of "latitude, longitude, altitude and bubble diameter" in the spatial range information are not present in some of the independent claims (namely claims 1, 23 and 32) as argued by applicants. Thus, applicants have not effectively directed any arguments towards the Section 102 rejections of these independent claims. The limitation of "bubble diameter" on the spatial range information first appeared (and currently appears) in dependent claim 2, and was addressed as such in the grounds for rejection of this claim in the first Official action (also repeated above). Namely, Ihara's spatial range information includes a bubble diameter in the form of the "dispsize" attribute shown and discussed with regard to Figures 13-14 of the Ihara reference. Therefore, Ihara's spatial range information does include a "bubble diameter" [dispsize]

as claimed. Furthermore, the spatial range information of Ihara v. Gale thusly includes latitude, longitude, altitude and "bubble diameter" as shown in the first Official action and repeated above.

Referring further to applicants' remarks on page 30 regarding the Gale reference: Applicants argued that Gale does not mention a bubble diameter of an object, a server that retrieves a DTD information based on an exemplary list of items, or a feature for the user to obtain information on buildings from exemplary input.

First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the user can obtain information on buildings within e.g. 1 100-m-range from a position of the user"...and any items argued following "e.g.") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, in response to applicant's arguments against the Gale reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Referring finally to applicants' remarks on pages 30-31 regarding the Section 103 rejections: Applicants argued that Gale is not in the same field as the Ihara reference

as well as the present invention and should not be combined with Ihara, and further that there is no suggestion or motivation to make such a combination of the prior art.

The examiner disagrees for the following reasons: In response to applicant's argument that Gale is nonanalogous art, it has been held that a prior art reference must either be in the field of applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Gale is in the same field as both Ihara and applicants' endeavor in that it is concerned with navigation and mapping based on geographical data in a database, as clearly evidenced by the Titles and Abstracts of Gale, Ihara and the present application.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, suggestion and motivation to combine is found in the references themselves through Ihara's silence on the measure of the third dimension, and Gale's reasoning for the usage of altitude as a third dimension. Specifically, as shown in the first Official action and repeated above, Gale's reasoning for altitude as a third dimension is to enable a user to specify elevation

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(or number of levels above/below street level) of a desired object. Therefore, given both references, one of ordinary skill in the art would have been motivated by Gale's reasoning to use Gale's altitude as the measure of Ihara's third dimension in order to fill the void in Ihara's disclosure of an explicit measure for the third dimension.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 703-305-7821. The examiner can normally be reached on M-F, 9 AM - 5 PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg  
09 June 2004

  
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